

## REMARKS

Independent claims 1 and 9 are rejected under 35 USC 102 for anticipation by a Kirkelund, et al. (4,491,505) but no such reference is of record. Therefore, a next Action cannot be final if it is not the allowance deserved.

A Kirkelund, et al. (4,941,505) is of record and, therefore, considered. It discloses an oil supply system for a burner nozzle, whereas independent claims 1 and 9 are in Jepson or improvement form to a fire extinguishing method and apparatus. Such fire extinguishing method and apparatus cannot be anticipated by an oil burner.

The Action indicates that the preamble of the Jepson claims is merely the name of the method and apparatus, but this is not the case.

The terms in both the preamble describing the prior art and those elements constituting the improvement are substantive claim limitations. 37 CFR § 1.75(e) *Wells Mfg. Corp. v. Littlefuse, Inc.*, 192 USPQ 256 (7<sup>th</sup> Cir. 1976).

The *MPEP* agrees:

The determination of whether preamble recitations are structural limitations can be resolved only on review of the entirety of the application "to gain an understanding of what the inventors actually invented and intended to encompass by the claim." *MPEP* 2111.02 (citation omitted).

In this case, the entirety of the application refers especially to fire extinguishing apparatus at, for example, page 1, lines 7-8 (as numbered), page 2, line 33 (as numbered), page 3, line 34 (as numbered), page 4, line 33 (as numbered), page 5, line 31 (as numbered), page 6, line 12, and page 7, line 7 (as numbered), i.e., on each and every page. Anyone must gain an understanding from this that the inventor actually invented and intended to encompass by claims 1 and 9 the fire extinguishing apparatus of the preamble.

Anyone must have an understanding that a fire-extinguishing apparatus is not an oil supply to a burner as in the Kirkelund, et al. patent.

The Action suggests that Kirkelund, et al. teaches a fire extinguishing system because it could cut off oil supply. However, in fire extinguishing, the fire is supplied elsewhere. The Action also suggests that Kirkelund, et al. teaches a fire extinguishing system because it could supply so much oil that it smothers a fire, but the expression "adding fuel to a fire" suggests that such requires the "rational underpinning" of the post KSR Guidelines for rejections.

... [R]ejections on obviousness cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some underpinning to support the legal conclusion of obviousness. *Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.*, Fed. Reg. October 10, 2007, 57526, 57528-9.

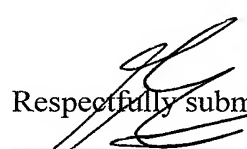
Even if the law were not followed that the preamble of a Jepson claim is a limitation, the dependent claims are still patentable, because different as well as for a new, fire-extinguishing use. The rule that no product patent may issue for a new use of an old product is tempered by the doctrine of slight changes. If the old product is altered, however slightly, to fit the new fire-extinguishing use, then there is no novelty bar. See, *Chisum on Patents*, § 1.03[8][b].

While the statute grants monopolies only for new structures, and not for new uses, invention is not to be gauged by the necessary physical changes, so long as there are some, but by the directing conception which alone can beget them. *H.C. White v. Morton E. Converse & Son Co.*, 20 F.2d 311, 312, 313 (2<sup>nd</sup> Cir. 1927).

In this regard, claims 2, 5 and 6 require flow restriction, but the Action cites pressure regulating valve 18 of the Kirkelund, et al. patent. Claim 3 requires recirculation if a temperature is reached, not at any temperature, as in the Action or the patent, which has no temperature response. Claim 4 also requires temperature response, to which the Action relates pressure, like a Doctor who used a thermometer to measure blood pressure.

Reconsideration and allowance are, therefore, requested..

Respectfully submitted,



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